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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,712	06/23/2003	Michael Francis Dube	14150-00601	5751
25243	7590	10/16/2006		
KELLEY DRYE & WARREN LLP 3050 K STREET, NW SUITE 400 WASHINGTON, DC 20007				
			EXAMINER MAYES, DIONNE WALLS	
			ART UNIT 1731	PAPER NUMBER

DATE MAILED: 10/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/600,712

Applicant(s)

DUBE ET AL.

Examiner

Dionne Walls Mayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,13,15-18,21-30,33,35-37,40,41,44,45 and 47-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 33 is/are allowed.
- 6) ☒ Claim(s) 1,3-10,15-18,21-30,35-37,40,41,44,45 and 47-60 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1,3,5,8,9-10,16,18,21,23-26,29-30,36,41,44-45, 51-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Leake et al (US. Pat. No. 3,428,049).

Leake discloses all that is recited in the claims (See Fig. 1, and cols. 2-3) since Leake discloses a tobacco smoke filter element, attached to a tobacco rod, having a cylindrical sleeve of compressed absorbent material ("inner filter material"), defining a cavity, contained within uncompressed filter material ("outer filter material"), said sleeve containing a frangible capsule containing a tobacco smoke-treating liquid medium ("breakable capsule"). An additional filter is provided on the side of the filter element farthest from the tobacco rod.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1, 3-10, 15-16, 18, 21-30, 35-36, 41, 44-45, 47-55, 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berger et al (US. Pat. No. 3,599,646) in view of Dock (US. Pat. No. 3,625,228).

Berger et al discloses nearly all that is recited in the claims, since it teaches a tobacco rod 22, and a filter element 20 connected to said rod. The filter element 20 has an inner member 36 (corresponding to the claimed "inner element of filter material"), comprised of a filter material which may be cellulose acetate, which has a cavity 48 which can be configured such that it faces/is exposed to the tobacco rod 22. Filter element 20 also has an outer member 34 (corresponding to the claimed "outer element of filter material" since, due to its paper construction, obviously renders it a material capable of filtering some amount of matter from cigarette smoke). The filter element 20 has all of the structural elements recited in the claims, either as explicitly stated, represented by the figures or inherently. While Berger may not specifically state that at least one breakable capsule is disposed in the cavity, it does state that materials for flavoring smoke may be provided in the cavity (see col. 1, lines 54-58). Further, Dock discloses heat-activated capsules, appearing to be the claimed sizes, that rupture upon exposure to heat and are designed to be disposed within cigarette filters to deliver flavorants to the user during the smoking of the cigarette (see cols. 1 and 2, and Fig. 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated one or more of these capsules into the cavity of the filter of the combined Berger references in order to receive the benefit of heat-activated capsules for imparting much-desired flavor, i.e. menthol, to cigarette smoke.

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Also, the filter of Berger modified by Dock would contain regions in said cavity for receipt of capsule contents following rupture of said capsule(s).

Lastly, since the filter segment of Berger modified by Dock is the same, structurally, as that of the instant invention, it follows that it would also be capable of exhibiting the same characteristic of decompressing/attaining a functional shape after compressing.

5. Claims 15,17,35,37,40,55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leake et al (US. Pat. No. 3,428,049).

While Leake et al may not specifically state that either the inner or outer filter elements are made of the materials claimed, it follows that one having ordinary skill in the art would have fabricated either of the filter materials of fibrous materials such as cellulose acetate since such is conventional material of fabrication for cigarette filters.

Allowable Subject Matter

6. Claim 33 is allowed.

7. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed August 4, 2006, regarding the prior art applied in the previous art rejection, have been fully considered but they are not persuasive.

- Applicant argues that the Leake reference fails to disclose a "cavity with a second region for receipt of capsule contents" or "excess air space

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unoccupied by a breakable capsule". The Examiner disagrees, and draws Applicant's attention to Fig. 1, and the space surrounding cylindrical sleeve 7. This is considered by Examiner to be the "excess air space" or "second region". Any claim language reciting or suggesting a condition occurring after the rupture of the breakable capsule, is not deemed to patentably distinguish the claims from the Leake reference because said language is functional. Applicant is reminded that the instant claims are drawn to a product which is distinguishable over the prior art in terms of structure, and not function. The product of Leake anticipates the stated claims due to the fact that structurally it meets the limitations of the claims.

- Applicant argues that the cavity of Leake is embedded within filter material and is unexposed to the tobacco rod/second filter element. The Examiner disagrees, and believes that the cavity disclosed in Leake, whether embedded in filter material or not, extends from the tobacco rod and/or second filter element, as clearly shown in Fig. 1.
- The Examiner is not convinced by Applicants arguments concerning the Berger modified by Dock product as being unreadable on the instant claims due to the fact that Dock utilizes capsules that would potentially wet the tobacco of Berger modified by Dock. However, the Examiner points out that Dock, as mentioned by Applicant, discloses the use of a "buffer member" to prevent leakage of fluid into the tobacco, and the Examiner believes that it would not be outside the purview of one having ordinary skill to still receive

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the benefits of the capsules of Dock by utilizing a means, such as a buffer member, to prevent the undesirable wetting of tobacco.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne Walls Mayes whose telephone number is (571) 272-1195. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (571) 272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Dionne Walls Mayes
Primary Examiner
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October 11, 2006